

REMARKS

Claims 1, 2 and 4 are pending in this application. By the Office Action, claims 1, 2, and 4 are rejected under 35 U.S.C. §112. In view of the following remarks, reconsideration and allowance are respectfully requested.

Rejection Under 35 U.S.C. §112

The Office Action rejects claims 1, 2, and 4 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserts that the specification as filed fails to describe the limitation of claim 1 of "a single type" of transparent fine particles. Applicants respectfully traverse the rejection.

It is well accepted under 35 U.S.C. §112 that the function of the description requirement is to ensure that Applicant had possession, as of the filing date of the application relied on, of the specific subject matter later claimed by him. See In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). There is no requirement that claims be limited to the scope of preferred embodiments.

The first paragraph of 35 U.S.C. §112 requires that the scope of the claims bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art. However, claims need not be limited to preferred embodiments of a described invention. In line with this statement, the Court of Customs and Patent Appeals in In re Johnson and Farnham, 194 USPQ 187, 195 (CCPA 1977) (citing In re Goffe, 191 USPQ 429, 431 (CCPA 1976)), exemplified:

[T]o provide effective incentives, claims must adequately protect inventors. To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

In the present case, the claim limitation "a single type" of transparent fine particles is fully and adequately disclosed in the specification as to evidence that Applicants had

possession, as of the filing date of the application, of the specific claimed subject matter. For example, at pages 6-7 under the heading "c) Transparent fine particles" the specification provides a description of exemplary transparent fine particles that can be used in the invention. The paragraph concludes by stating that "[I]n use, one or two or more of the plastic beads may be selected" (emphasis added). Although this passage does not expressly state one "type" of transparent fine particle, the clear implication is that the passage describes the use of "one or two or more" types of particles, as a single solitary particle would not provide adequate results in a film.

Furthermore, the Examples in the specification provide further support for the claim limitation. At least Examples 1-11 describe embodiments where "a single type" of transparent fine particle is used in producing the anti-dazzling film.

In support of the rejection, the Office Action points only to page 4, lines 12-13 and original claim 3. The Office Action argues that two or more type of transparent fine particles are preferred. However, page 4, lines 12-13 by its express teaching relates to "a third embodiment" and is in no way limiting of the entire invention disclosed in the specification. In fact, the cited passage of page 4 relates to original claim 3 in particular, and is exemplified by at least Example 12.

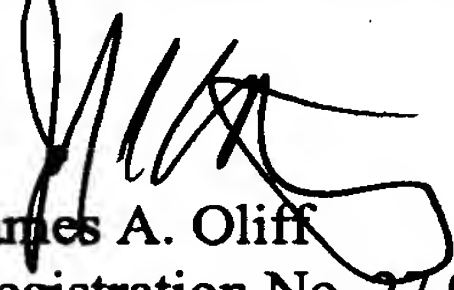
Because the claim limitations are clearly and abundantly described in the specification as filed, the claims satisfy the requirements of 35 U.S.C. §112, first paragraph. Reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1, 2 and 4 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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